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No. 83-2128

In the Supreme Court of the United States

OCTOBER TERM, 1983

RAYTHEON COMPANY,
PETITIONER,

v.

ROPER CORPORATION,
RESPONDENT.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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I

Counterstatement of the Question Presented

Is a patented invention for an oven ventilation system, which was found by both the District Court and the Court of Appeals to be unobvious and clearly infringed, also "useful" under the patent statute, when the claimed invention unquestionably performs the very useful ventilation function described in its patent specification and has been successfully incorporated in 24,000 of the respondent's ovens and over 36,000 of the petitioner's infringing ovens?

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Counterstatement of the Case

As noted by the Court of Appeals for the Federal Circuit in its opinion below, petitioner Raytheon Company (hereinafter "Raytheon") ignored most of the findings of fact of the District Court and attempted on appeal to argue the evidence *de novo* (B76).[1] Although this attempt was unsuccessful, Raytheon has taken the same approach here in its Statement of the Case. As a result, respondent Roper Corporation (hereinafter "Roper")[2] believes this counterstatement is warranted.

[1] The references herein are to the Petitioner's Appendices A and B, and most relate to the findings of fact or conclusions of law of the District Court or to the opinion of the Court of Appeals for the Federal Circuit.

[2] With reference to Rule 28.1 of the Rules of the Supreme Court of the United States, Roper has no parent companies and one not wholly owned subsidiary, Wadsworth Control Systems, Inc., a Colorado corporation. Sears, Roebuck and Company, however, does own a portion (less than 50%) of Roper stock.

Roper owns U.S. Patent No. 4,028,520 issued to Sumner H. Torrey (hereinafter "the Torrey patent"), which covers a ventilation system for a unique type of oven called a common cavity oven. A common cavity oven has three basic modes of operation: (1) conventional thermal cooking, (2) microwave cooking, and (3) pyrolytic self-cleaning (B4). These multiple functions all take place in the same oven cooking chamber, called the oven cavity; hence the name "common cavity" (B4). As found by the District Court these three oven modes of operation were not entirely compatible from an oven ventilation standpoint, at least prior to the Torrey invention (B5-6).

Most foods give off grease-laden vapors ("steam") as they cook, and these vapors tend to collect inside the oven cavity. In conventional thermal ovens, this steam is removed by creating an air flow through the oven cavity so that the steam is flushed through a vent in the oven top (usually in the control panel area). This air flow is often created by providing a small access opening to the oven cavity at the bottom of the oven door. When the oven cavity heats up because of the cooking process, air from outside the oven is convected into the oven cavity through the access opening. The air flows through the oven cavity and up and out the top vent, sweeping the steam along with it (B6).

This small convected air flow, however, is inadequate to properly ventilate a microwave oven. In microwave cooking, the food cooks much faster and the steam collects much more rapidly (B7). This substantial amount of hot "steam" from microwave cooking is also a potential safety hazard, for when the oven door is first opened, the collected steam can rush out of the oven and into the oven operator's face (B10). As a result, the ventilating air flow through the oven cavity must be increased during microwave cooking to prevent steam build-up, and this is most often accomplished by making additional use of some of the already-existing microwave oven structure (B7).

In a microwave oven, microwaves are generated by an electronic tube called a magnetron, and the microwaves then pass into a hollow metal waveguide which directs the microwaves into the oven cavity. The microwave-generating magnetron heats up when in use, and a fan forces cooling air over it whenever the magnetron is on (B6-7). Some of this blown air can be channeled to pass into the hollow waveguide, and by opening up the end of the waveguide to the oven cavity, this blown air will also flow into the oven cavity itself and ventilate the oven during microwave cooking (B7, B11).

If thermal and microwave cooking are combined in the same oven cavity (the "common cavity" oven), the prior art taught (and the District Court found) that this strong flow of forced air must be sent through the open waveguide even during thermal cooking because of a problem known as waveguide fouling (B10-12). If the waveguide is simply left open, steam or cooking vapors from the thermal cooking process will flow back into the open waveguide and deposit on and contaminate the waveguide's inside walls, adversely affecting oven performance (B11-12). The strong flow of forced air through the waveguide, however, would keep the conventional cooking vapors out, and no fouling would occur. Thus, the waveguide would be protected from fouling by blowing air through it during both microwave cooking and thermal cooking.

When pyrolytic self-cleaning is added to the common cavity oven, the ventilation problem becomes more complicated. Pyrolytic self-cleaning involves heating the oven walls to about 900°F. to pyrolyze the soil on the walls, producing airborne byproducts that need to be ventilated out of the oven. The potential for waveguide fouling during self-cleaning exists because of these airborne byproducts. As found by the District Court, the basic solution of continuously blowing air through the waveguide to prevent fouling could not be used where pyrolytic self-cleaning is part of the oven (B7-9). This is

because of an effect called autoignition. Autoignition is an infrequent and momentary combustion, involving a very brief but significant increase in the temperature and pressure inside the oven cavity (B8). Under normal household self-cleaning conditions autoignition is mild and infrequent (B24). Autoignition, however, becomes a violent explosion, capable of blowing open the oven door, buckling the oven floor and possibly resulting in a sustained fire inside the oven cavity (B8, B64) if the air flow into the oven is above a certain very low level. The amount of forced air needed to keep vapors and byproducts out of the waveguide would be well above this safety limit (B8-9, B12).

As found by the District Court, the prior art common cavity oven makers were unable to protect the open waveguide in all three modes by blowing air through it, and, therefore, they protected the waveguide from fouling by sealing the oven cavity end of it (B10, B13, B64-65). As a result there was no forced air ventilation in those ovens during microwave cooking, and those prior art ovens had serious steam problems (B10, B40, B65).

With this the state of the art in 1973, the respondent, Roper, began development of its own common cavity oven with self-cleaning (B16). Sumner Torrey, a Roper senior development engineer, designed Roper's prototype (B18). Torrey discovered that a self-cleaning, common cavity oven could indeed be ventilated in all three modes of operation (microwave cooking, thermal cooking and pyrolytic self-cleaning) without waveguide fouling, if the system were properly arranged and certain operating conditions were followed.

Initially, Torrey positioned the waveguide below the oven cavity and opened it at the bottom of the cavity. He then arranged an air passageway from an air inlet below the oven cavity through the open waveguide and up into the oven cavity. Naturally convected air was then drawn through the waveguide and into the oven cavity during thermal cooking

and self-cleaning. Air was blown through the same passageway during microwave cooking (B18-20). A simplified, cross-sectional side view of an oven embodying the Torrey ventilation system is shown in both the District Court's opinion (B57) and in that of the Court of Appeals (B67).

Because of Torrey's invention, for the first time a self-cleaning common cavity oven was properly ventilated in all three modes (thermal, microwave and self-cleaning). As found by the District Court, this was something never before accomplished (B41).

Raytheon throughout this entire litigation has *never once denied* the following: if one took the Torrey patent and built the structure disclosed in it, the end result would be a working self-cleaning common cavity oven which ventilates properly in all three modes of operation, which exhibits no waveguide fouling, and which limits the air intake to below the level at which self-cleaning autoignitions become violent explosions —an entirely useful result not accomplished by the prior art. Indeed, this is precisely the major object of the invention, as set forth in the patent itself ((A7), col. 1, lines 55-59):

> "*It is a general object to provide a ventilating system for a common cavity oven usable in all three modes of operation* and which is safe in all three of the modes and which runs no risk of violent explosion of the products of combustion in the self-clean mode." (Emphasis ours.)

And it is this major object which the Court of Appeals found was met by the invention of claims 2 to 7 of the Torrey patent (B91-92).[3]

---

[3] The best Raytheon can do in its Petition is to repeatedly allege that this general object is also met by the prior art ovens (e.g., Petition pp. 28-29), a position it has never before taken in the few years this case has been pending. The reason Raytheon never raised this argument before is that it is false and directly contrary to the findings of fact below. As found as fact by the District Court, and unchallenged by Raytheon on appeal to the Court of Appeals, the prior art ovens did not ventilate during one of the three modes of operation, microwave cooking, because the waveguides were sealed to prevent fouling (B9-10, B14).

Roper introduced its common cavity oven with the Torrey ventilation system to the market in 1976, and as found by the District Court it became a very successful commercial product with some 24,000 sold, none of which ever exhibited any steaming problems or waveguide fouling (B22).

Raytheon began its development of a self-cleaning common cavity oven in early 1975 (B22). After about fourteen months of effort, however, Raytheon's prototype oven cooked poorly and had a serious steam problem during microwave cooking (B23). In January, 1976, however, Buddy J. Austin, who was one of Torrey's key engineers on Roper's common cavity project, joined Raytheon's subsidiary, Amana, and was immediately put to work on Raytheon's floundering common cavity project (B23-24). Within about a month, Raytheon's oven changed dramatically (B24-25), and, as found by the District Court, the result was a virtual copy of Roper's oven including Torrey's unique ventilation system (B27).

Raytheon then put its common cavity oven on sale, and Roper charged Raytheon with infringement. Raytheon brought suit in the District of Massachusetts for a declaratory judgment that the Torrey patent was invalid and not infringed by Raytheon's oven.

On January 20, 1983, the District Court found that the Torrey ventilation system was completely unobvious (B39-43) and that the Torrey claims were indeed clearly infringed by the Raytheon ovens (B48-53). However, relying both on Raytheon's oven tests which were, as noted by the Court, "not typical of normal use" (B22), and Raytheon's argument (which it presents here) that the real invention was not a ventilation system at all (B43), the District Court concluded that the Torrey ventilation system, which accomplished what no other such system had done before and which had been incorporated in almost 60,000 Roper and Raytheon ovens, "lacked all utility". The Torrey patent was held invalid. Roper appealed on the utility issue, while Raytheon cross-appealed on the issues of non-obviousness and infringement.

On December 30, 1983, the Court of Appeals for the Federal Circuit (CAFC) reversed the District Court's decision as to lack of utility for claims 2 to 7 of the Torrey patent, and affirmed the lower court's decision as to non-obviousness and infringement. Raytheon sought a rehearing, which was denied, and Raytheon has now petitioned for certiorari, once again essentially asserting that the Torrey ventilation system, which it copied into over 36,000 of its ovens, lacks all utility, a claim it has to date neglected to tell its common cavity oven customers.

Summary of the Argument

I. Petitioner Raytheon's effort to create a conflict with prior decisions of this Court misstates what the Court of Appeals said and misinterprets a single remark in *Mitchell* v. *Tilghman*, 86 U.S. (19 Wall.) 287 (1873). The Court of Appeals never said that utility unrelated to the problem to be solved by the patent would suffice. And *Mitchell* v. *Tilghman* does not say that all claims of a patent must meet *all* objects stated in the specification.

II. It is simply a matter of common sense that Raytheon, having been adjudicated an infringer of certain of the Torrey patent claims, cannot thereafter be heard to argue that what it infringed is useless. However, Raytheon was never prevented from simultaneously arguing at trial non-infringement and lack of utility. The estoppel to deny utility was invoked only after infringement was determined.

III. The CAFC did not violate F.R.Civ.P. 52(a) in construing claims 2-7 as not requiring prevention of backflow. It has long been settled, including by a long line of authority in this Court, that construction of the claims is a question of law.

IV. Raytheon's argument that appeal estoppel precluded Roper from contending that the patent was directed to a ventilation system, rather than a backflow prevention device, is not supported by the trial record, as the CAFC correctly pointed out in its opinion.

Argument

I. The Decision of the Court of Appeals Is Not in Conflict With Applicable Decisions of This Court.

Essentially Raytheon's whole effort to create a conflict with prior decisions of this Court is grounded on a misreading of the CAFC's opinion and a misinterpretation of a single remark in *Mitchell* v. *Tilghman*, 86 U.S. (19 Wall.) 287 (1873).

Raytheon erroneously alleges that the Court of Appeals held that a showing of utility for some purpose, even if that was not the purpose for which the patent was granted, would satisfy the statutory requirement of utility (35 U.S.C. §101) (Pet. 25). To the contrary, the CAFC held that the inventions claimed in claims 2-7 of the patent in suit all met at least one *stated* object of the invention, and a major one at that. This was the general object of providing a "ventilating system for a common cavity oven usable in all three modes of operation and which is safe in all three modes and which runs no risk of violent explosion of the products of combustion in the self-clean mode" (A7, col. 1, lines 55-59). Raytheon's suggestion, without any supporting evidence, that this object had no relation to why the patent was sought in the first place not only ignores the very title of the patent ("Air Flow System For Common Cavity Oven"), but more importantly, ignores the strictures of F.R.Civ.P. Rule 52(a). For the District Court found as fact, and the CAFC agreed, that persons of ordinary skill (including the major manufacturers Litton and General Electric) were unable to devise a common cavity oven with proper ventilation and a pyrolytic self-cleaning feature prior to the Torrey invention (B40-41; B102-3). In other words, contrary to the concurrent findings of the two lower courts, Raytheon asserts now that this object was meaningless because it was already met by "every *self-cleaning* oven on the market prior to the time of the alleged invention". This assertion is absurd on its face because the general object is clearly limited to *common cavity* ovens with self-cleaning (the three modes are

microwave cooking, thermal cooking, and self-cleaning), and the assertion is unsupported by any evidence, because the prior art GE and Litton ovens did not have proper ventilation, a finding of fact unchallenged by Raytheon before the Court of Appeals.

Significantly, Raytheon nowhere denies that the inventions of claims 2-7 all meet this important, central and hitherto unachievable stated objective. Nor does any decision of this Court cited by Raytheon hold that such an achievement does not satisfy the statutory requirement of utility.

Raytheon's misplaced reliance on *Mitchell* v. *Tilghman*, 86 U.S. (19 Wall.) 287 (1873), was correctly pointed out by the CAFC and never effectively rebutted in the Petition. We cannot improve upon Chief Judge Markey's analysis (B90-91)[4]:

> "3. A claimed invention need not accomplish all objectives stated in the specification.
>
> The district court held the '520 patent invalid in part because Roper's oven, as set forth in claims interpreted by the district court as requiring prevention of backflow and autoignition, failed to accomplish all objectives stated in the patent. Raytheon urged at oral argument that the holding is compelled by *Mitchell* v. *Tilghman*, 86 U.S. 287, 396-97 (a patent is void "if the described result cannot be obtained by the described means"). In *Mitchell*, the described result was production of fatty acids and glycerin from fatty or oily substances by the action of water at high temperature and pressure. *Id.* at 296, 380. That was the single result stated and was an element of the *claim*. *Id.* at 296. To interpret *Mitchell* as requiring that all claims must set forth inventions satisfying all objectives would make no sense. When a properly claimed invention meets at least one stated objective,

[4] We note in passing that the holdings with regard to claim construction and lack of operability in *Mitchell* v. *Tilghman* were overruled in *Tilghman* v. *Proctor*, 102 U.S. 707 (1880).

utility under §101 is clearly shown. *See e.g.*, *Standard Oil Co. (Indiana)* v. *Montedison, S.P.A.*, 664 F.2d 356, 375, 212 USPQ 327, 344 (3rd Cir. 1981), *cert. denied*, 456 U.S. 915, 102 S.Ct. 1769, 72 L.Ed.2d 174 (1982); *E. I. duPont de Nemours & Co.* v. *Berkley & Co.*, 620 F.2d 1247, 1258 n.10, 1260 n.17, 205 USPQ 1, 8 n.10, 10 n.17 (8th Cir. 1980); *Krantz and Croix* v. *Olin*, 148 USPQ 659, 661-62 (CCPA 1966); Chisum on Patents, ¶4.04[4] [1983]."

Nor is there any conflict with *O'Reilly* v. *Morse*, 56 U.S. (15 How.) 62, 119 (1853), or *Beidler* v. *United States*, 253 U.S. 447, 453 (1920) (Pet. 29-30). The language in *O'Reilly* is the same as that in *Mitchell* v. *Tilghman*, and the quotation from *Beidler* makes clear that the patent was struck down there because the description in the patent did not enable one following it to achieve a useful result (properly developed photographs). Here, Raytheon has never denied that by following the description in the Torrey patent one would obtain a common cavity oven that has proper ventilation in all modes and is safe to the user, as evidenced by the 24,000 ovens sold by Roper and having no ventilation or explosion problems, as found by the District Court (B22), and over 36,000 more infringing ovens sold by Raytheon. That the CAFC found this a useful result was a matter of common sense.

II. Once the Petitioner Was Determined To Be an Infringer, Its Argument That It Copied a Worthless Invention Was Properly Given Little Weight

It is virtually black letter law that once infringement is found, the infringer is estopped to assert lack of utility of the invention in question. This has been the Supreme Court's position in *Lehnbeuter* v. *Holthaus*, 105 U.S. 94 (1881); *Western Electric Co.* v. *LaRue*, 139 U.S. 601, 608 (1891); *Gandy* v. *Main Belting Company*, 143 U.S. 587, 595-96 (1892); *DuBois*

v. *Kirk*, 158 U.S. 58 (1895) and *Westinghouse Co.* v. *Wagner Mfg. Co.*, 225 U.S. 604 (1912).

This line of authority has been uniformly followed by courts up until this day, including in the recent cases of *E. I. duPont de Nemours* v. *Berkley & Co., Inc.*, 620 F.2d 1247 (8 Cir. 1980); *Tapco Products Co.* v. *Van Mark Products Co.*, 446 F.2d 420 (6 Cir. 1971), and *Miller* v. *Daybrook-Ottawa Corp.*, 291 F.Supp. 896 (N.D. Ohio 1968).

And the rule makes perfect sense. In fact, in totally rejecting the same argument that Raytheon makes here (that this estoppel doctrine "reads §101 out of the patent statute"), the CAFC said (B94-95):

> "A correct finding of infringement of otherwise valid claims mandates as a matter of law a finding of utility under §101. *The rule is not related, as Raytheon argues, to whether a defendant may simultaneously assert non-utility and non-infringement; a defendant may do so.* The rule relates to the time of decision, not to the time of trial, and is but a common sense approach to the law. If a party has made, sold, or used a properly claimed device, and has thus infringed, proof of that device's utility is thereby established. People rarely, if ever, appropriate useless inventions." (Emphasis ours.)

Raytheon, of course, did not choose here to point out any error in the Court of Appeals' analysis and instead simply repeats the argument that failed below.

III. The Decision of the Court of Appeals Is in Conformity With F.R.Civ.P. Rule 52(a).

Raytheon accuses the CAFC of violating Rule 52(a) (Pet. 53) and turning away from "nearly two centuries of precedent in this Court" (Pet. 49). It is Raytheon, however, which has ignored the precedents of this Court. The CAFC correctly

held, consistently with this Court's precedents, that construction of the claims is a question of law and went on to find that the District Court had, as a matter of law, misconstrued claims 2-7 (B81-89).

This Court long ago determined that construction of the patent and of the claims is a question of law. *Silsby* v. *Foote*, 55 U.S. (14 How.) 218, 225 (1852); *Winans* v. *Denmead*, 56 U.S. (15 How.) 330, 338 (1853); *Bates* v. *Coe*, 98 U.S. 31, 38-39 (1878), and *Coupe* v. *Royer*, 155 U.S. 565, 579 (1895). Indeed in the very opinion earlier cited by Raytheon, *Beidler* v. *United States*, 253 U.S. 447 (1920), this Court stated (253 U.S. at 451):

> "Treating this finding by the [lower] court as an interpretation of the patent and, therefore, as a conclusion of law...."

More recently, many circuit courts of appeals in addition to the CAFC have reached the same conclusion: *Devex Corp.* v. *General Motors Corp.*, 667 F.2d 347, 357 (3 Cir. 1981), *aff'd on other grounds*, 103 S.Ct. 2058 (1983); *Ebeling* v. *Pak-Mor Mfg. Co.*, 683 F.2d 909, 911-912 (5 Cir. 1982); *Vulcan, Inc.* v. *Fordees Corp.*, 658 F.2d 1106, 1111 (6 Cir. 1981); and *Solomon* v. *Renstrom*, 150 F.2d 805, 807-8 (8 Cir. 1945).

Hence, the CAFC did not violate Rule 52(a) and was in conformity with this Court and other circuits when it construed the claims. Nor does Raytheon cite any contrary authority. *Graver Mfg. Co.* v. *Linde*, 338 U.S. 605 (1950), cited by Raytheon at Pet. 53, simply holds that the issue of equivalence is a question of fact. The CAFC agreed and in this case found that the District Court's finding of equivalence was subject to the Rule 52(a) clearly erroneous standard (B105-6), and was not clearly erroneous. Likewise, Raytheon's reliance on *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), (Pet. 50) is also misplaced. *Graham* held that a determination of non-obviousness had to be based upon three *factual* inquiries. Here

the CAFC reviewed the District Court's findings of fact underlying its determination of non-obviousness and found them not clearly erroneous.

In all, the CAFC opinion is an excellent example of the proper scope of appellate review of issues of claim construction, utility, non-obviousness and infringement.

IV. The Petitioner's "Appeal Estoppel" Argument Was Properly Rejected by the Court of Appeals After It Reviewed the Trial Court Record.

Raytheon apparently realized that it was impossible to prove that the Torrey ventilation system did not ventilate the oven properly (its own 36,000 infringing ovens being a big hurdle on that score), and took a different tack on the question of utility. Raytheon set out to convince both the trial court and the CAFC that Torrey had not patented an oven ventilation system at all but rather a backflow and autoignition prevention device.

In fact, Raytheon asserted before the CAFC (and before this Court now) that Roper should be estopped from arguing that the Torrey invention was an oven ventilation system, because, according to Raytheon, Roper did not argue that at the trial level. The CAFC, however, reviewed the record and made short work of Raytheon's "appeal estoppel" argument (B85-87):

> "Raytheon says Roper is precluded by an 'appeal estoppel' from contesting the inclusion of 'no backflow during autoignition' in all claims because Roper relied on 'no backflow' in the District Court and should not be allowed to change its theory on appeal. Examination of the trial record, however, reveals that Roper there stressed the theory it urges on appeal [that the invention is an oven ventilation system that works in all three modes without fouling the waveguide], and that it was *Raytheon* which

> argued that the 'essence' of Roper's invention was no backflow during autoignition.
>
> * * *
>
> * * * The unchallenged evidence established that Roper's ovens experienced no fouling or contamination. There is no basis in the record, therefore, for the imposition of an 'appeal estoppel' precluding Roper from reliance on the claims as written and allowed." (Emphasis in original.)

Indeed, if anyone has changed its theory on appeal, it is Raytheon. At trial Raytheon argued that Torrey had claimed two inventions: (1) an invention to prevent backflow during all autoignitions (claims 1, 3 and 4) (B29) and (2) an invention which prevents autoignition entirely (claims 1, 2, 5 and 7) (B29). This construction of the claims was the basis on which the claims were originally found by the trial court to lack any utility (B29).

During the appeal, as specifically noted by the CAFC, Raytheon abandoned its argument that claims 1, 2, 5 and 7 were for inventions to prevent autoignition (B87-88). Unfortunately for Raytheon, this left independent claims 2 and 5 unchallenged. So, for the first time, Raytheon now asserts that *all* the claims are for an invention to "prevent backflow during autoignition", while complaining that it is Roper which changed its position on the appeal.

Raytheon's argument on this point is not only meritless, as the CAFC's review of the entire record indicated, but in view of Raytheon's own change in its position, Raytheon is in a particularly poor position to assert the argument at all.

Conclusion

For the foregoing reasons, the petition should be denied.

Respectfully submitted,

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